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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/998,302 12/24/97 STANFIELD J STE01-P798B

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EXAMINER

ZIMMERMAN, B

ART UNIT

PAPER NUMBER


2735

DATE MAILED:

01/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/998,302	Applicant(s) Stanfield	
	Examiner Brian Zimmerman	Group Art Unit 2735	

☒ Responsive to communication(s) filed on Nov 3, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-63 is/are pending in the application.

Of the above, claim(s) 2-10, 14-38, and 42-63 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 11-13, and 39-41 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

EXAMINER'S RESPONSE

Status of Application.

1. In response to the applicant's amendment received on 11/5/99. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1,11,12,13,39,40,41 are unpatentable for the reasons set forth in this office action:

INFORMALITIES

10 2.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2-6,23-33, drawn to addressable humanly perceptible **alerting** mechanism in a file locating system, classified in class 340, subclass 825.52.
- 15 II. Claims 7-10,19,61,62, drawn to **network configuration** in a file locating system, classified in class 340, subclass 825.08.
- III. Claims 11-13,39-⁴²~~41~~, drawn to the **structure** of a file folder in a file locator system, classified in class 340, subclass 693.
- IV. Claims 14-18,20-22,53-60,63 drawn to a **retainer** in a file locator system, classified in class 340, subclass 825.49.
- 20 V. Claims ⁴²~~42~~-52, drawn to **database storage** in a file locator system,

classified in class 364, subclass 401.

VI. Claims 34-38, drawn to a **conductor arrangement** on files to be located, classified in class 340 subclass 825.54.

5 3. Claim 1 will be examined with either of groups I-III. Due to the lack of burden at this time a species election is not required between the species of retainers claimed, however if burden can be established at a future time, such an election may be required.

10 Following is a chart which shows the claims that will be examined based upon the election of a specific group.

	Group Elected	Claims Examined
	I	1-6,23-33
15	II	1,7-10,19,61,62
	III	1,11-13,39-41
	IV	14-18,20-22,52,55-60,63
	V	43-52
	VI	34-38

20

4. Inventions I and II are related as subcombinations disclosed as usable together

in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as leading a human to the location of the folder. See MPEP § 806.05(d).

5 5. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as locating a file using over the air signaling. See MPEP § 806.05(d).

10 6. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as locating a loose folder not physically connected to another element. See MPEP § 806.05(d).

15 7. Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as locating or indicating to a human, the location of a file. See MPEP § 806.05(d).

20 8. Inventions I and VI are related as subcombinations disclosed as usable together

in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as locating or indicating to a human with over the air signals. See MPEP § 806.05(d).

5 9. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as reading information from a storage media on the file (equal to the files contents). See MPEP § 806.05(d).

10

10. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as writing data to a storage media on the file from a stand alone data writer. See
15 MPEP § 806.05(d).

11. Inventions II and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility
20 such as monitoring who has worked on a particular file. See MPEP § 806.05(d).

12. Inventions II and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as interacting file information to provide data about the file to various locations on a LAN. See MPEP § 806.05(d).

13. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as connecting file electronics to a data writer for storing information on a file. See MPEP § 806.05(d).

14. Inventions III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as connecting file electronics to a data writer for storing information on an electronic portion of a file. See MPEP § 806.05(d).

15. Inventions III and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate

utility such as connecting file electronics to a data writer for storing information on an electronic portion of a file. See MPEP § 806.05(d).

16. Inventions IV and V are related as subcombinations disclosed as usable
5 together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as store files requiring power to maintain data. See MPEP § 806.05(d).

17. Inventions IV and VI are related as subcombinations disclosed as usable
10 together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as store files requiring power to maintain data. See MPEP § 806.05(d).

18. Inventions V and VI are related as subcombinations disclosed as usable
15 together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as providing information on who has had the file last. See MPEP § 806.05(d).

20 19. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification,

restriction for examination purposes as indicated is proper.

20. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-VI, restriction for examination
5 purposes as indicated is proper.

21. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Groups I,III,IV,V or VI, restriction for examination purposes as indicated is proper.

10

22. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I,II,IV,V,VI, restriction for examination purposes as indicated is proper.

15 23. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group I-III,V,VI, restriction for examination purposes as indicated is proper.

20 24. Because these inventions are distinct for the reasons given above and the search required for Group V is not required for Group I-IV,VI, restriction for examination purposes as indicated is proper.

25. Because these inventions are distinct for the reasons given above and the search required for Group VI is not required for Group I-V, restriction for examination purposes as indicated is proper.

5

26. The election of Group III in paper number 14 is acknowledged. The following rejection pertains to the elected group of claims.

27. The restriction requirement is hereby made Final.

10

ART REJECTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20

28. Claims 1,11-13,38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (5455409) and either Gillotte (5424858) or Kott (4376936).

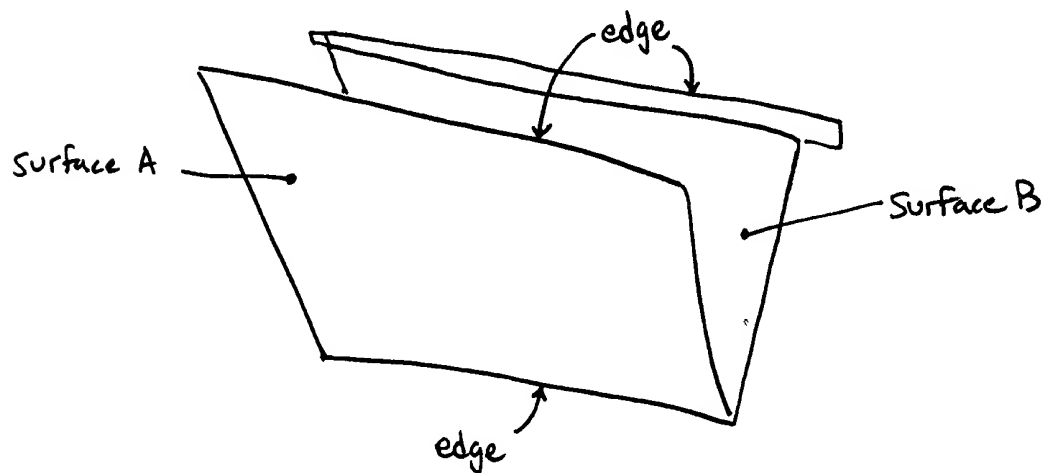
Smith shows a file tracking system in which a processor is connected to a bus which is connected to a folder retainer 12. the processor sends information to a folder such that a indicator displays the lactation of the folder to a user requesting to know the

location of the folder. Smith discloses that the use of a data base to maintain the location information is an alternative to the distributed database system. It is pointed out that Smith does in fact disclose the use of a central database in a file retrieval system, however Smith chooses not to utilize such a database. See abstract. From
5 this suggestion, the skilled artisan would reliably be able to efficiently update and manage a database of information.

In an analogous art, Kott shows a file folder which is placed in a file retainer and communicates with the retainer via a conductive bus. The file includes conductors on the file folder configured to couple the folder to a retainer. Viewing the Sketch 1 below
10 to show the examiner' interpretation of the elements of a file, it is clear that Kott shows a file with a conductor located on the surface of the file. Kott also shows a retainer with rails to suspend the file and provide a data communication as well as a ground. Kott's folder has the contacts on the side and edge of the surface of the folder. Therefore, it would have been obvious to one of ordinary skill in the art at the time of
15 the invention to have utilized the folder of Kott to store documents information in a filing system which can communicate to the folders in the manner suggested by Kott since such would provide the cheap communication with the file.

In an analogous art, Gillotte also shows a file folder which is placed in a file retainer and communicates with the retainer via a conductive bus. The file includes
20 conductors on the file folder configured to couple the folder to a retainer. Viewing the Sketch 1 below to show the examiner' interpretation of the elements of a file, it is clear

that Gillotte shows a file with a conductor located on the surface of the file. Gillotte also shows a retainer with rails to suspend the file and provide a data communication as well as a ground. Gillotte's folder has the contacts on the side and edge of the surface of the folder. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Gillotte to store documents information in a filing system which can communicate to the folders in the manner suggested by Gillotte since such would provide the cheap communication with the file.



REMARKS

Response to Arguments.

The following discussion is introduced in direct response to the arguments presented in the instant amendment: it is noted that due to the applicant's election of Group III, the remarks regarding claims now withdrawn from consideration are moot.

29. The applicant argues the following:

a. The applicant argues that the restriction in this application is improper since it is "inconsistent" with the restriction made in the parent application.

b. The applicant argues that the examiner has not properly set forth the restriction requirement since, it is the applicant's position that the examiner has not complied with MPEP 806.05(d) (section cited by applicant) regarding restriction of subcombinations usable together. The applicant then states that the standard for this type of restriction is whether one of the subcombinations has a utility different from the disclosed combination...

c. The applicant argues that the utility examples given by the examiner in the restriction is incorrect, since the particular claims in question do not include any reference to the elements required to perform the given utility.

30. In response, the examiner points out the following:

a. MPEP 811.04 states:

Even though inventions are grouped together in a requirement in a parent case, restriction there among may be required in the divisional case if proper.

5 b. First it is pointed out that the applicant's citation of the MPEP is incorrect.

MPEP 806.50(d) states:

Subcombinations Usable Together

10 Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other.

Care should always be exercised in this situation to determine if the several subcombinations are generically claimed. (See MPEP § 806.04(b).)

15 Form Paragraph 8.16 may be used in restriction requirements between subcombinations.

The applicant's cite of the MPEP also includes some portion of MPEP 804(b) which is
20 not relevant since there currently is no election of species requirement. Since the applicant's position of the standard for making a subcombinations usable together restriction is based on their misquoted citation of the MPEP, the arguments are flawed and incorrect. The standard for this type of restriction, has been fully described and complied with in the restriction of 7/28/99 and repeated above. Therefore all
25 arguments regarding the subcombinations being required by the "disclosed combination" are meritless. Furthermore, all arguments regarding a species election requirement are moot, since no such election requirement was given.

c. Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually

distinct from each other. The utility given by the examiner is an example of how the claimed group can be used separately. These given utilities are examples, and are not given as the definition of the group, therefore whether the claimed group includes elements to perform the utility is not a question here, merely if the group can be used in
5 a system which performs the example utility.

31. All Double Patenting rejections based upon Patent 5751221 have been
10 overcome by the filing of a Terminal Disclaimer, which is now of record.

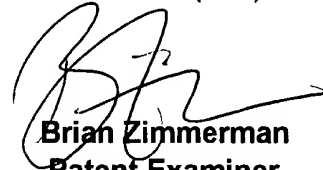
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CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Zimmerman whose telephone number is (703) 305-4796.

- 5 Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Brian Zimmerman
Patent Examiner
Art Unit 2735

10

703-305-4796
January 07, 2000